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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------------|---------------------|------------------|
| 09/677,502 | 10/02/2000 | Yoshio Hashibe | 0694-134 | 4484 |
| 7590 05/19/2005 | | | | |
| Bradley N. Ruben PC 463 First St. Suite 5A Hoboken, NJ 07030 | | EXAMINER SERGENT, RABON A | | |
| | | ART UNIT 1711 | | |
| | | PAPER NUMBER | | |

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/677,502

Applicant(s)

HASHIBE ET AL.

Examiner

Rabon Sergeant

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1, 2, 4, 6, 8, 11, and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support has not been provided for claiming that the film has an average reflectance of “12% or more to 19% or less for visible rays” (claim 1) or “about 15% for visible light” (claims 11 and 12). The specification only provides support for reflectance values for visible light of 15% or less (page 3) and 12% and 19% (Table 1). The language, “12% or more to 19% or less” and “about 15%” encompasses values that are not supported by the specification. Data set forth within examples provides support only for values that correspond to the data. Despite applicants’ argument, applicants have not established that they were in possession of values derived from the extrapolation of values within the examples at the time of invention. Therefore, the position is maintained that there is no evidence that applicants were in possession of values that exceed 15% at the time of invention, other than the experimental value of 19%. Contrary to applicants’ arguments, the rejection is not based upon a lack of enablement; the rejection is based upon the position that the argued claimed subject matter is new matter. Furthermore, the examiner has clearly set forth why the argued subject matter is considered to be new matter.

2. Claims 1, 2, 4, 6, and 8-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. Support has not been provided for claiming that the heat-ray reflection film is “made of a material consisting essentially of indium oxide containing tin, antimony oxide containing tin, tin oxide containing fluorine, and tin oxide containing antimony”. The amended claim language requires that the heat-ray reflection film contain all four of these components; however, neither original claim 5 nor the specification provides support for such a film. The specification merely discloses at page 3 that, as the film, use may be made of an indium oxide film containing tin, an antimony oxide film containing tin, a tin oxide film containing fluoride, or a tin oxide film containing antimony. At no place does the specification provide support for a film made from a material consisting essentially of all four claimed species.

3. The prior art rejections have been withdrawn in view of applicants’ amendment requiring that the heat-ray reflection film be made from a material consisting essentially of indium oxide containing tin, antimony oxide containing tin, tin oxide containing fluorine, and tin oxide containing antimony. As aforementioned, the claim language requires that the film contain all four recited species; however, the prior art is silent with respect to such a film.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent
May 15, 2005